

AF 3652
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2000 University Avenue
East Palo Alto, CA 94303-2248
www.graycary.com
O] 650-833-2055
F] 650-833-2001

February 27, 2004
Via Email and U.S. Mail

Our File No. 1020843-991180

Dr. Alexander Esslinger
Betten & Resch
P.O. Box 10 02 51
D-80076 Munchen
Germany

Re: U.S. Patent Application No. 09/810,374 for:
Title: PICKING APPARATUS
Filed: March 15, 2001
Our Reference: 1020843-991180
Your Reference:

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Dear Dr. Esslinger:

In connection with the above-identified U.S. patent application, the Examiner has now issued a final Office Action, a copy of which is enclosed for your reference. The deadline for responding to the Office Action is **April 6, 2004**. This deadline is extendable to July 6, 2004 with the payment of escalating extension fees. Because it is a final rejection, we would like to respond as soon as possible.

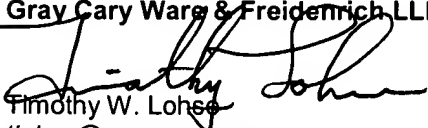
Claims 2-14 and 16-20 are pending in this application. The Examiner has rejected claim 14 for indefiniteness and claims 2, 4-8, 10, 12, 14, 17 and 18 as double patenting over U.S. Patent 6,602,037 to Winkler as specifically described in the enclosed office action. Copies of the Winkler patent and the Office Action are enclosed for your reference. A terminal disclaimer will overcome the double patenting rejection.

Please have the inventor review the patent and provide me with comments about the technical differences between the cited patent and the claimed invention. The Examiner also did not consider the foreign language articles and requires an explanation of the relevance of the articles. Therefore, please provide us with these explanations so we can forward them to the Examiner.

Please contact me if you have any questions.

Very truly yours,

Gray Cary Ware & Freidenrich LLP


Timothy W. Lohse
tlohse@graycary.com

TWL:cap
Enclosures



KJS

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,374	03/15/2001	Walter Winkler	1020843-991180	8757

26379 7590 01/06/2004

GRAY CARY WARE & FREIDENRICH LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

EXAMINER

FOX, CHARLES A

ART UNIT PAPER NUMBER

3652

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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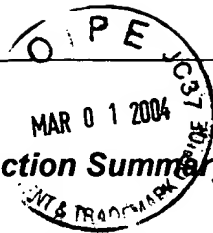
PATENT DOCKET
DATE: <u>Jun 12, 2004</u>
ACTION: <u>Resp to F. Oj. / Inter Appeal</u>
DUE: <u>06 Apr. 1 2004</u>
DEAD: <u>06 July 2004</u>

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Office Action Summary



Application No. 09/810,374		Applicant(s) WINKLER, WALTER	
Examiner Charles A. Fox		Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4-8, 10, 12, 14, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 3, 9, 11, 13, 16, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19. 6) ☐ Other:

Information Disclosure Statement

The information disclosure statement filed October 27, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each document listed that is not in the English language. It has been placed in the application file, but the information therein which has been lined through has not been considered. All initialed documents have been considered.

Claim Objections

Claims 3,911,13 and 16 are objected to because of the following informalities: the claim was not included in the latest amendment and there is no indication that the claim has been cancelled. Appropriate correction is required. Claims 3, 9, 11, 13 and 16 must be presented or cancelled in response to this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "ergonomically advantageous" is not properly defined as this height would be different for each user of the device. Individuals may change the settings as needed, but only after a setting based on the quantity of articles on the retrieval pallet is determined. Therefore it is indeterminate as to how the

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ergonomic advantageous retrieval height is established. In the below rejection of claim 14 the ergonomic advantages of the device are not treated as they are not defined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2,4-8,10,12,14,17 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,24,27,28,31-36, 38 42 and 44 of U.S. Patent No. 6,602,037. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of independent claim 14 in the instant invention are all present in claim 27 and the claims from which it depends of U.S. Patent No. 6,602,037. The dependent claims in the instant application are nearly word for word copies of the dependent claims from the above mentioned U.S. Patent. The table below list the matching of the claims in regards to this rejection.

Claims in instant application	Matching claims in US 6,602,037
14	1,24,27
2,4	28
5	31
6	32
7	33
8	34
10	36
12	38
17	42
18	44

Response to Amendment

Amendment C filed on September 26, 2003, has been entered into the record.

Response to Arguments

Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Fox whose telephone number is 703-605-4294. The examiner can normally be reached between 7:00-5:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached at 703-308-3248. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

CAF
CAF
12-29-03

EILEEN D. LILLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600



#19

Form PTO-1449 (modified 2/91) INFORMATION DISCLOSURE CITATION (Use several sheets if necessary)	U.S. DEPT. OF COMMERCE Patent and Trademark Office	Attorney Docket Number: 1020843-991180	Serial Number: 09/810,374
		Applicant: Walter Winkler	
		Filing date: March 15, 2001	Group art unit: 3652

U.S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

	Document number	Date	Country	Class	Sub-class	Translation	
						YES	NO
P2	2 413 089	03-19-74	Germany				X
P2	0 442 000 B1	11-23-94	Europe				X
P2	44 37 568 C1	10-20-94	Germany				X
P2	2 98-13-848 v1	7-23-98	Germany				X

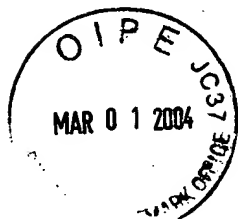
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

02	English translation of the German Office Action corresponding to DE 100 13 213.6-22 dated July 21, 2003 citing all the references listed herein.
02	DE-Z: Fördermitteljournal 1-2/1995, S. 32
02	GB-Z: Materials Handling News, Juli 1977, S. 26
02	DE-Z: Hebezeuge und Fördermittel, Berlin 36 (1996) 7/8 S. 317-319
02	DE-Z: Industrieanzeiger 17/1996 vom 22.04.1996, S. 52
02	DE-Z: Maschinenmarkt, Würzburg 82 (1976) 93 vom 19.11.1976, S. 1800
	DE 298 13 898 U1
	Die Entgegenhaltung (1) zeigt (vgl. Figuren 1-3, vgl. auch Entgegenhaltungen (6) and (9)) und beschreibt eine Vorrichtung zum Kommissionieren mit allen Merkmalen des Anspruchs 1. Der Anspruch 1 ist daher wegen fehlender Neuheit seines Gegenstandes nicht gewährbar.
	Die Unteransprüche 2-21 sind nach Wegfall des Bezugsanspruchs aus formalem Grund ebenfalls nicht gewährbar.
	Die Lehren der Ansprüche 2-4 sind ebenfalls aus Entgegenhaltung (1) bekannt.
	Die Lehre des Anspruchs 5 ist aus Entgegenhaltungen (2) und (3) bekannt.




	Die Lehre des Anspruchs 6 ist aus Entgegenhaltungen (1) und (2) (vgl. die Figuren) bekannt.
	Die Lehre des Anspruchs 7 ist aus Entgegenhaltung (5) nahegelegt.
	Die Lehre des Anspruchs 8 ist aus Entgegenhaltung (6) nahegelegt.
	Die Lehre des Anspruchs 9 ist aus Entgegenhaltung (5) (vgl. Spalte 3 unten) nahegelegt.
	Die Lehre der Ansprüche 10 und 11 sind aus Entgegenhaltung (1) (vgl. Figuren 1-3) bekannt.
	Die Lehren der Ansprüche 13 und 14 sind aus Entgegenhaltung (5) (vgl. Spalte 3, unten) nahegelegt.
	Die Lehre des Anspruchs 17 ist aus Entgegenhaltung (1) nahegelegt.
	Die Lehre des Anspruchs 18 ist aus Entgegenhaltung (6) (vgl. auch Entgegenhaltung (9)) bekannt.
	Die Lehre des Anspruchs 19 ist aus Entgegenhaltung (4) bekannt.
	Die Lehre des Anspruchs 20 ist aus Entgegenhaltung (7) nahegelegt.
	Die Lehre des Anspruchs 21 ist aus Entgegenhaltung (8) nahegelegt.
	Zu den Ansprüchen 12, 14, 15 wird auf Entgegenhaltung (10) verwiesen.
	Der zuständige Fachmann wird diese Maßnahmen bei entsprechenden Automatisierungsanforderungen anwenden.
	Bei diesem Prüfungsergebnis kann eine Patenterteilung nicht in Aussicht gestellt werden.

Examiner: <i>Cummins</i>	Date Considered: 12-20-03
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP '609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.	



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Notice of References Cited 	Application/Control No. 09/810,374	Applicant(s)/Patent Under Reexamination WINKLER, WALTER	
	Examiner Charles A. Fox	Art Unit 3652	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,602,037	08-2003	Winkler, Walter	414/273
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.